

In re Application of: Gil Ronen et al.
Serial No.: 10/561,220
Filed: April 4, 2006
Office Action Mailing Date: January 30, 2008

Examiner: WORLEY, Cathy Kingdon
Group Art Unit: 1638
Attorney Docket: 30698

REMARKS

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 1-4 and 6-52 are in this Application. Claims 9-52 have been withdrawn from consideration. Claim 3 has been objected to. Claim 7 has been rejected under 35 U.S.C. § 101. Claims 1-4, 6-8 have been rejected under 35 U.S.C. § 102. Claims 1, 3 and 7 have been amended herewith. Withdrawn claim 9 has been amended herewith.

Sequence Rule Compliance

The Examiner states that the application contains sequence disclosures that are encompassed by the definitions for the nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2), however, the application fails to comply with the requirements of 37 CFR § 1.821-1.825 because the Applicant has not provided a statement that the computer-readable format and the hard copy of the sequence listing are identical. The compliance statement requested is attached hereto as a separate document.

Amendments To The Claims

Claim Objections

The Examiner states that claim 3 is objected to because it is grammatically incorrect.

Applicants have amended claim 3 to recite “*comprises*” instead of “*comprising*” according to Examiner’s suggestion, to thereby overcome Examiner’s objection.

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35 U.S.C. § 101 Rejections

The Examiner has rejected claim 7 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Examiner states that the current recitation in claim 7 encompasses transgenic human cells and therefore it does not constitute statutory subject matter. The Examiner's rejections are respectfully traversed.

In order to expedite prosecution of this case Applicants have amended claim 7 to recite "*A transgenic plant cell*" (Emphasis added), to thereby overcome Examiner's rejection.

Ample support for the amendments made in claim 7 can be found in instant application as filed, see for example, Page 15, lines 1-7.

35 U.S.C. § 102 Rejections

The Examiner has rejected claims 1-3, 7 and 8 under 35 U.S.C. 102(b) as being anticipated by Larkin et al. (Plant Cell, 1993, 5:1739-1748). The Examiner states that the claims are drawn to an isolated polynucleotide comprising "a" nucleic acid sequence as set forth in SEQ ID NO:23, and to a construct, transgenic cell and a transgenic plant comprising the polynucleotide, and that the use of the article "a" renders this recitation includes of fragments of SEQ ID NO:23 as small as dinucleotides, and since the GL1 promoter taught by Larkin et al., comprises "gatat" which is "a" nucleic acid sequence as set forth in SEQ ID NO:23, it anticipates the claimed invention. The Examiner's rejections are respectfully traversed.

In order to expedite prosecution of this case Applicants have elected to cosmetically amend claim 1 to recite "*comprising the nucleic acid sequence as set forth in SEQ ID NO: 23*" (Emphasis added), to thereby overcome Examiner's rejections.

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The Examiner has rejected claims 1-4, 6-8 under 35 U.S.C. 102(b) as being anticipated by Wan et al. (JBC, 1996, 271:31227-31233) as evidenced by SP6 promoter sequencing primer catalog page from Fermentas Life Sciences (2000). The Examiner states that the claims are drawn to an isolated polynucleotide comprising "a" nucleic acid sequence as set forth in SEQ ID NO:23, and to a construct, transgenic cell and a transgenic plant comprising the polynucleotide, and that the use of the article "a" renders this recitation includes of fragments of SEQ ID NO:23 as small as dinucleotides; that Wan et al. teach constructs encoding the pkg transit peptide fused to the cab protein, and that *in vitro* transcription of each construct was initiated by the SP6 promoter which comprises the "TAT" sequence, and therefore it is "a " nucleic acid sequence of SEQ ID NO:23. The Examiner's rejections are respectfully traversed.

In view of the amendment made in claim 1 ("the" instead of "a") Examiner's rejections are rendered moot.

In view of the above amendments and remarks it is respectfully submitted that claims 1-4 and 6-8 are now in condition for allowance. A prompt notice of allowance is respectfully and earnestly solicited.

Should the product claims be found allowable Applicants respectfully request rejoining of the withdrawn and currently amended process claims 12-20 and 21-30 pertaining to same.

Respectfully submitted,



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Date: May 26, 2008

Encls:

- Petition for Extension (one month)
- Sequence Rule Statement